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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,330	02/16/2001	Luigi J.F. Canali	P 278080	1904
909	7590	04/06/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			SHAH, ANKEETA	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	

3628

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,330

Applicant(s)

CANALI ET AL.

Examiner

Ankeeta Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-129 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 32-61, 64, 77-94, 97 and 110-129 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-31, 62, 63, 65-76, 95, 96 and 98-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species II (Fig. 19) claims 1,2,5-31,62,63,65-76,95,96 and 98-109 in the reply filed on 2/4/2005 is acknowledged. The traversal is on the ground(s) that A. the invention must be independent or distinct and B. there must be a serious burden on the examiner. This is not found persuasive because seven distinct species have numerous elements that should be searched and analyzed. Further, the seven species are independent.

A. Examiner clearly identifies the patentably distinct species as stated in the previous Office Action.

Further, the applicant has not submitted evidence or identified such evidence now of record showing the species to be obvious variants or clearly admitted on the record that this is the case.

B. Contrary to the applicants assertion, complete and full examination of all the identified species requires diversified search fields. Further the examination process includes not only the search of references but also analysis of the found references. Thus, examination of all the species having different features would pose a serious burden to the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,2,5-12,14-28,30,31,62,63,65-76,95,96 and 98-109 rejected under 35 U.S.C. 102(e) as being anticipated by Gindlesperger (US PAT 6,397,197).

Re Claim 1 and 95: A method for an auction composing:

receiving, through a network, a request for an item from a first machine (i.e. buyer, see col7,39), the request for the item(i.e. product, see abstract) being based on a performance specification of the item(i.e. product specification, see col9, 24-25); sending, through the network, the request for the item to a second machine(i.e. "vendor", see col8, 3); and receiving, through the network, a bid from the second machine(i.e. "vendor", see col8, 3), the bid being based on the request for the item(see abstract).

Re Claim 2 and 96: The method, wherein the first machine includes a first computer operated by a potential consumer (i.e. buyer, see col4, 60), second machine includes a second computer operated by a potential vendor (i.e. "vendor", see col4, 65).

Re Claim 5 and 98: The method, further comprising
sending, through the network, the request for the item to a third machine(i.e. vendor , see col4, 65);
receiving, through the network, a second bid from the third machine, the second bid being based on the request for the item(see col8, 3-5); and
determining a result of an auction based on (i) the request for the item, (ii) the first mentioned bid and (iii) the second bid(i.e. the product, see col7, 62-63).

Re Claim 6: The method, wherein the first machine includes a first computer operated by a potential consumer(i.e. buyer, see col4, 60), the second machine includes a second computer operated by a first potential vendor (see col4, 65), and the third machine includes a third computer operated by a second potential vendor(i.e. plurality of vendors, see col4, 65).

Re Claim 7: The method, wherein the determination of the result of the auction is based on a match between the request for the item (see col7, 39-42) and at least one of (i) the first mentioned bid and (ii) the second bid (see col8,3-8), the match including at least one of (i) an exact match between the request for the item and at least one of the

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mentioned bid and the second bid and (ii) at least one of the first mentioned bid and the second bid satisfying the request for the item (see col8, 3-10).

Re Claim 8: The method, wherein the request for the item, the first mentioned bid, and the second bid include at least one of (i) performance risk of a potential vendor, (ii) price, (iii) warranty and (iv) performance specification of an item(see col5, 23-24).

Re Claim 9: The method, further comprising ranking the first mentioned bid and the second bid based on a comparison between (i) the request for the item and (ii) the first mentioned bid and the second bid (see col7, 60-65 and col8, 3-6).

Re Claim 10: The method, further comprising sending at least one of (i) a first status and (ii) a second status to at least one of (i) the second computer and (ii) the third computer, wherein the ranking includes the first status for the first mentioned bid and the second status for the second bid (see col5, 18-35), the status indicating one of (i) a leading bid and (ii) a lagging bid (see col5, 28-35).

Re Claim 11,12,14 and 15: The method, further comprising receiving a third bid from at least one of (i) the second computer and (ii) the third computer (i.e. the vendors, see col8, 3-8), the ranking of the bids by the vendors (see abstract).

Re Claim 16 and 101: The method, wherein the request for the item is sent to the second machine based on (i) the request for the item (i.e. the product, see col7, 60-61) and (ii) data on at least one potential vendor(see col8, 3).

Re Claim 17: The method, further comprising sending, through the network, an invitation to the first machine to submit the request for the item; the first machine submitting the request for the item based on the invitation (see abstract and col7, 39-41).

Re Claim 18,28,30,31,70 and103: A method for an auction comprising: receiving, through a network, a request for an item from a first machine (i.e. buyer, see col7, 39) sending, through the network, the request for the item to a second machine and to a third machine (i.e. to the vendors, see col8, 3-5); receiving, through the network, a first bid from the second machine and a second bid from the third machine(i.e. vendors, see col8, 3-5), the first bid and the second bid being based on the request for the item(see col7, 60-61 and col8, 3-5); and determining (i) a first result of an auction based on the request for the item and the first bid (see col7, 60-67 and col8, 1-10), (ii) a second result of an auction based on the request for the item and the second bid (see col7, 60-67 and col8, 1-10), and (iii) a third result of an auction based on the first result and the second result (see col7, 60-67 and col8, 1-10).

Re Claim 19, 71 and 104: The method, wherein the first machine includes a first computer operated by a potential consumer (i.e. buyer, see col7, 39-40), the second

machine includes a second computer operated by a first potential vendor (see col8, 3-5), and the third machine includes a third computer operated by a second potential vendor(i.e. one or more vendors, see col8, 3-5).

Re Claim 20, 72, and 105: The method, wherein the request for the item from the potential consumer (i.e. buyer, see col7, 39-40) is based on at least one of (i) a performance specification of the item and (ii) a term of the request for the item (i.e. product specification, see col9, 24-25).

Re Claim 21: The method, wherein the determination of the third result of the auction is based on a match between the request for the item (see col7, 39-42) and at least one of (i) the first mentioned bid and (ii) the second bid (see col8,3-8), the match including at least one of (i) an exact match between the request for the item and at least one of the mentioned bid and the second bid and (ii) at least one of the first mentioned bid and the second bid satisfying the request for the item (see col8, 3-10).

Re Claim 22,74 and 107: The method, wherein the request for the item, the first bid, and the second bid include at least one of (i) performance risk of potential vendor, (ii) price, (iii) warranty and (iv) performance specification of an item (see col5, 58-59).

Re Claim 23, 75 and 108: ranking the first bid and the second bid based on a comparison between (i) the request for the item and (ii) the first bid and the second bid (see abstract, col7, 60-67 and col8, 1-10).

Re Claim 24: The method, further comprising sending at least one of (i) a first status and (ii) a second status to at least one of (i) the second computer and (ii) the third computer, wherein the ranking includes the first status for the first bid and the second status for the second bid(see col5, 18-35), the status indicating one of (i) a leading bid and (ii) a lagging bid(see col5, 28-35).

Re Claim 25: The method, further comprising receiving a third bid (see col8, 3-8) from at least one of (i) the second computer and (ii) the third computer (see col8, 3-8), the ranking of the bids by the vendors (see abstract).

Re Claim 26,76 and 109: The request for the item is sent to the second machine and the third machine based on (i) the request for the item (i.e. the catalog contains all the items information, see col5, 44-50) and (ii) data on at least one potential vendor (see col5, 44-50).

Re Claim 27: The method, further comprising sending, through the network, an invitation to the first machine to submit the request for the item, the first machine submitting the request for the item based on the invitation (see abstract and col2, 8-12).

Re Claim 62 and 65: An apparatus for an auction comprising:

a receiver to receive (Gindlesperger does not explicitly disclose the receiver, "element 8" receives data from "element 6" in Fig 1, and to receive data there has to be a receiver)

(i) a request for an item from a first machine (i.e. buyer requests for a product, see col7,39-47) and (ii) a bid from the second machine (i.e. "vendor", see col8, 3) ;

a transmitter to send the request for the item to a second machine (Gindlesperger does not explicitly disclose a transmitter, the data is transmitted to the vendors (see col8, 3-4), to transmit data there has to be a transmitter), and

a memory device (Gindlesperger does not explicitly disclose a memory device, data is stored in PrintProSys.SM server (see col7,17-19), thus to store data there has to be a memory device) coupled to the receiver and the transmitter, the memory device (the data received from the customer is stored and transmitted to the vendor thus it is coupled) being configured to store (i) the request for the item and (ii) the bid (see col7, 49-60), wherein (i) the request for the item is based on a performance specification of the item (i.e. product specification, see col9, 24-25) and (ii) the bid is based on the request for the item (i.e. the product, see col7, 62-63).

Re Claim 63: The method, wherein the first machine includes a first computer operated by a potential consumer (i.e. buyer, see col4, 60), second machine includes a second computer operated by a potential vendor (i.e. "vendor", see col4, 65).

Re Claim 66: The method, wherein the first machine includes a first computer

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operated by a potential consumer(i.e. buyer, see col4, 60), the second machine includes a second computer operated by a first potential vendor (see col4, 65), and the third machine includes a third computer operated by a second potential vendor(i.e. plurality of vendors, see col4, 65).

Re Claim 67and 106: The method, wherein the determination of the result of the auction is based on a match between the request for the item (see col7, 39-42) and at least one of (i) the first mentioned bid and (ii) the second bid (see col8,3-8), the match including at least one of (i) an exact match between the request for the item and at least one of the mentioned bid and the second bid and (ii) at least one of the first mentioned bid and the second bid satisfying the request for the item (see col8, 3-10).

Re Claim 68: The method, wherein the request for the item, the first mentioned bid, and the second bid include at least one of (i) performance risk of a potential vendor, (ii) price, (iii) warranty and (iv) performance specification of an item(see col5, 23-24).

Re Claim 69: The method, further comprising sending, through the network, an invitation to the first machine to submit the request for the item, the first machine submitting the request for the item based on the invitation (see abstract and col7, 39-41).

Re Claim 73: The method, wherein the determination of the third result of the auction is based on a match between the request for the item (see col7, 62-63) and at least one of (i) the first mentioned bid and (ii) the second bid (see col8, 3-8), the match including at least one of (i) an exact match between the request for the item and at least one of the mentioned bid and the second bid and (ii) at least one of the first mentioned bid and the second bid satisfying the request for the item (see col8, 3-10).

Re Claim 99: The method, wherein the first machine includes a first computer operated by a potential consumer (i.e. buyer, see col7, 39), the second machine includes a second computer operated by a first potential vendor (i.e. "vendor", see col8, 3), and the third machine includes a third computer operated by a second potential vendor (i.e. "one or more vendors", see col8, 3).

Re Claim 100: The method, wherein the determination of the result of the auction is based on a match between the request for the item(see col7, 62-63) and at least one of (i) the first mentioned bid and (ii) the second bid (see col8, 3-8), the match including at least one of (i) an exact match between the request for the item and at least one of the mentioned bid and the second bid and (ii) at least one of the first mentioned bid and the second bid satisfying the request for the item (see col8, 3-10).

Re Claim 102: The method, further comprising sending, through the network, an invitation to the first machine to submit the request for the item, the first machine submitting the request for the item based on the invitation (see abstract and col2, 8-12).

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Re Claim 106: The method, wherein the determination of the result of the auction is based on a match between the request for the item (see col7, 39-42) and at least one of (i) the first mentioned bid and (ii) the second bid (see col8,3-8), the match including at least one of (i) an exact match between the request for the item and at least one of the mentioned bid and the second bid and (ii) at least one of the first mentioned bid and the second bid satisfying the request for the item (see col8, 3-10).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Gindlesperger (US PAT 6,397,197).

Re Claim 13: Gindlesperger does not disclose: The method, wherein an operator of the first machine submits to mediation based on the result of the auction.

The examiner notes that mediation is required when there is a potential conflict.

It would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger to discuss related issues such as payment terms and conditions in regard to winning items.

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Re Claim 29: Gindlesperger does not disclose: The method, wherein an operator of the first machine submits to mediation based on the result of the auction.

The examiner notes that mediation is required when there is a potential conflict.

It would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger to discuss related issues such as payment terms and conditions in regard to winning items.

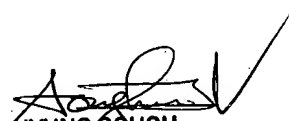
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ankeeta Shah whose telephone number is (703)305-0853. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703)308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600